



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/345,223	06/30/1999	DEAN J. BLACKKETTER	14531.82.2	9972

22913 7590 11/21/2003

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)

60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 11/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

KS

Office Action Summary

Application No.

09/345,223

Applicant(s)

BLACKKETTER ET AL.

Examiner

Reuben M. Brown

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 & 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty, (U.S. Pat # 5,848,352).

Considering claim 1, Dougherty meets the claimed subject matter by teaching objects may be transmitted to a subscriber's terminal and stored in memory. Thus the claimed method for creating custom advertisements in a timely manner for display with a TV program, such that the custom advertisements include custom advertisement information that can be transmitted over a low-bandwidth channel, comprising storing in a receiver an advertisement template that is identified by a first resource identifier reads on the disclosure of Dougherty, see col. 14, lines 6-15. Dougherty teaches that the compact protocol may be stored in a subscriber's terminal may include advertising, col. 6, lines 12-15; col. 9, lines 36-45 & col. 13, lines 1-6.

Art Unit: 2611

The claimed feature of monitoring low bandwidth data service channel for an advertisement summary that is addressed to the advertising template, such that advertisement summary includes a second resource identifier and custom advertisement information reads on the disclosure of Dougherty that the graphical object information is transmitted in the VBI, wherein the data extractor detects & extracts the compact protocol, col. 13, lines 44-55; col. 17, lines 21-46; col. 21, lines 35-40 & col. 23, lines 45-67 thru col. 24, lines 1-9

As for the additionally claimed feature of creating the custom advertisement by combining formatting information from the advertisement template and custom advertisement, when it is determined that the first and second resource identifiers match, Dougherty discloses that the information that is stored at the subscriber terminal is combined with specific format information that is transmitted over the VBI to create a custom image; see col. 17, lines 41-67; col. 19, lines 19-45; col. 20, lines 44-60; col. 24, lines 32-45.

Considering claim 2, Dougherty is directed to custom advertising.

Considering claim 3, the custom advertisement in Dougherty may include multiple additional objects added to an advertisement.

Considering claim 4, the resource identifiers in Dougherty identify the components of the custom advertisement and are at least local to a subscriber's system; col. 13, lines 12-25.

Art Unit: 2611

Considering claims 5, 12-14 & 21, comprise elements that correspond with subject matter mentioned above in the rejection of claim 1, and are likewise treated.

Considering claim 6, the custom advertisement of Dougherty may be broadcast to a plurality of receivers.

Considering claims 7-10, see col. 7, lines 21-44.

Considering claim 11, Dougherty discusses error checking, which reads on the claimed subject matter, col. 7, lines 45-51.

Considering claim 15, see col. 17, lines 55-67 & col. 21, lines 35-40.

Considering claim 16, Dougherty teaches the use of interactive buttons, which read on hyperlinks, col. 5, lines 60-67 & col. 19, lines 19-40.

Considering claims 17-18, the claimed time stamp and time-out features read on Dougherty, col. 17, lines 1-20.

Considering claim 19, see col. 13, lines 45-58.

Art Unit: 2611

Considering claim 20, Dougherty can display objects as a result of user selection or without user intervention, col. 5, lines 55-67; col. 20, lines 40-67.

Considering claim 23, see col. 13, lines 1-10.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty.

Considering claim 22, Dougherty teaches the benefit of using a low-bandwidth data channel but does not disclose the formula recited in the claim. Official Notice is taken that at the time the invention was made, bandwidth optimization techniques were known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Dougherty in a manner such that the stored data is of a value that is relatively small, at least in order to conserve memory space at the subscriber's terminal.

Art Unit: 2611

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Srinivasan Teaches time-stamped annotation data.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2611

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-6861 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9306 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown



VIVEK SRIVASTAVA
PRIMARY EXAMINER